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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,126	10/06/2000	Thomas R. Hull	10432/31	3216

757 7590 08/04/2003

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EXAMINER

NGUYEN, NHON D

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 08/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,126

Applicant(s)

HULL ET AL.

Examiner

Nhon (Gary) D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-32, 51 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: "a first page representation", "a first attribute representation".

Also as per claim 1, since a *first attribute representation* associated with a *first* of said one or more media/finishing attributes, it does not make sense that a *first indicator*, which belongs to the *first attribute representation*, indicates the applicability of said *one or more* media/finishing attributes.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted element is: "a first user input device".

Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted element is: "a first of said one or more media/finishing attributes".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9, 12-41, and 44-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Tonkin (US 6,134,568).

As per independent claim 1, Tonkin teaches an interface, implemented in a computer, for controlling a production printer comprising:

a display (fig. 5D);

a first page representation located on said display and operative to represent a portion of a document to be produced by said production printer (382 and 384 of fig. 5D), said portion characterized by the applicability of one or more media/finishing attributes (386, 388, 390, 392, 394, and 396 of fig. 5D); and

a first attribute representation associated with a first of said one or more media/finishing attributes and located on said display, said first attribute representation comprising a first indicator operative to visually indicate on said display, the applicability of said one or more media/finishing attributes to said portion (386, 388, 390, 392, 394, and 396 of fig. 5D).

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As per claim 2, which is dependent on claim 1, Tonkin teaches the one or more media/finishing attributes comprises hole punches (322 of fig. 5B; col. 7, lines 51-53).

As per claim 3, which is dependent on claim 1, Tonkin teaches the one or more media/finishing attributes comprises staples (320 of fig. 5B).

As per claim 4, which is dependent on claim 1, Tonkin teaches the one or more media/finishing attributes comprises media size (314 of fig. 5B).

As per claim 5, which is dependent on claim 1, Tonkin teaches the one or more media/finishing attributes comprises media color (318 of fig. 5B).

As per claim 6, which is dependent on claim 1, Tonkin teaches the one or more media/finishing attributes comprises media finish (342 of fig. 5B).

As per claim 7, which is dependent on claim 1, Tonkin teaches the one or more media/finishing attributes comprises media thickness (484 of fig. 6; col. 8, lines 54-60).

As per claim 8, which is dependent on claim 1, Tonkin teaches the one or more media/finishing attributes comprises media type (312 of fig. 5B; col. 7, lines 15-21).

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As per claim 9, which is dependent on claim 1, Tonkin teaches the one or more media/finishing attributes comprises binding (316, 317, and 318 of fig. 5B).

As per claim 12, which is dependent on claim 1, wherein said one or more media/finishing attributes comprises masking (431 of fig. 5F).

As per claim 13, which is dependent on claim 1, it is inherent in Tonkin's system to have one or more media/finishing attributes comprises plex.

As per claim 14, which is dependent on claim 1, it is inherent in Tonkin's system to have one or more media/finishing attributes comprises annotation.

As per claim 15, which is dependent on claim 1, it is inherent in Tonkin's system to have one or more media/finishing attributes comprises insertion.

As per claim 16, which is dependent on claim 1, it is inherent in Tonkin's system to have one or more media/finishing attributes comprises ordering.

As per claim 17, which is dependent on claim 1, Tonkin teaches the one or more media/finishing attributes comprise media source (312 of fig. 5F).

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As per claim 18, which is dependent on claim 1, it is inherent in Tonkin's system to have one or more media/finishing attributes comprise imposition.

As per claim 19, which is dependent on claim 1, Tonkin teaches the first attribute representation further comprises a menu (pull-down menu, e.g. 320 of fig. 5F), said menu comprising said first indicator (320 of fig. 5F) and a first attribute descriptor associated with said first indicator, said first attribute descriptor describing said first of said one or more media/finishing attributes (*Staple* describes attribute 320 of fig. 5F).

As per claim 20, which is dependent on claim 19, Tonkin teaches the first attribute representation comprises a second indicator and wherein said menu comprises said second indicator and a second attribute descriptor, said second attribute descriptor describing a second of said one or more media/finishing attributes and wherein said second attribute descriptor is associated with said second indicator (e.g. 322 of fig. 5F).

As per claim 21, which is dependent on claim 19, Tonkin teaches the first indicator comprises an asserted state and a deasserted state, wherein said asserted state indicates that first of said one or more media/finishing attributes applies to said portion (*upper left corner* or *top center*; col. 7, lines 47-48) and said deasserted state indicates that said first of said one or more media/finishing attributes does not apply to said portion (*none*; col. 7, lines 47-48).

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As per claim 22, which is dependent on claim 21, Tonkin teaches the first of said one or more media/finishing attributes further comprises one or more options and said indicator further comprises an option field (pull-down menu of attribute 320 of fig. 5F comprises one or more options) and wherein said asserted state further indicates one or more values of said one or more options (*upper left corner or top center*; col. 7, lines 47-48).

As per claim 23, which is dependent on claim 19, Tonkin teaches comprising a first user input device wherein said menu is coupled with said first user input device, said first user input device operative to select said first attribute descriptor (*mouse*, col. 4, line 59).

As per claim 24, which is dependent on claim 23, Tonkin teaches the first user input device is further operative to modify said first of said one or more media/finishing attributes (by changing different values in the pull-down menu, e.g. 320 of fig. 5F).

As per claim 25, which is dependent on claim 23, it is inherent in Tonkin's printing system to have the first user input device operatively applying said first of said one or more media/finishing attributes to said portion.

As per claim 26, which is dependent on claim 23, Tonkin teaches the first user input device is further operative to remove said first of said one or more media/finishing attributes from said portion (by setting the attributes to *none*; fig. 5F).

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As per claim 27, which is dependent on claim 1, Tonkin teaches the first attribute representation comprises a symbolic attribute representation for each of said one or more media/finishing attributes and wherein said first indicator is further operative to indicate said one or more media/finishing attributes by displaying said symbolic attribute representation in conjunction with said first page representation as applied to said portion (col. 7, lines 11-65).

As per claim 28, which is dependent on claim 27, it is rejected under the same rational as claim 21.

As per claim 29, which is dependent on claim 27, it is rejected under the same rational as claim 23.

As per claim 30, which is dependent on claim 29, it is rejected under the same rational as claim 24.

As per claim 31, which is dependent on claim 29, it is rejected under the same rational as claim 25.

As per claim 32, which is dependent on claim 29, it is rejected under the same rational as claim 26.

As per independent claim 33, it is rejected under the same rationale as claim 1.

As per claim 34, which is dependent on claim 33, it is rejected under the same rationale as claim 2.

As per claim 35, which is dependent on claim 33, it is rejected under the same rationale as claim 3.

As per claim 36, which is dependent on claim 33, it is rejected under the same rationale as claim 4.

As per claim 37, which is dependent on claim 33, it is rejected under the same rationale as claim 5.

As per claim 38, which is dependent on claim 33, it is rejected under the same rationale as claim 6.

As per claim 39, which is dependent on claim 33, it is rejected under the same rationale as claim 7.

As per claim 40, which is dependent on claim 33, it is rejected under the same rationale as claim 8.

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As per claim 41, which is dependent on claim 33, it is rejected under the same rationale as claim 9.

As per claim 44, which is dependent on claim 33, it is rejected under the same rationale as claim 12.

As per claim 45, which is dependent on claim 33, it is rejected under the same rationale as claim 13.

As per claim 46, which is dependent on claim 33, it is rejected under the same rationale as claim 14.

As per claim 47, which is dependent on claim 33, it is rejected under the same rationale as claim 15.

As per claim 48, which is dependent on claim 33, it is rejected under the same rationale as claim 16.

As per claim 49, which is dependent on claim 33, it is rejected under the same rationale as claim 17.

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As per claim 50, which is dependent on claim 33, it is rejected under the same rationale as claim 18.

As per claim 51, which is dependent on claim 33, it is rejected under the same rationale as claims 19 and 21.

As per claim 52, which is dependent on claim 51, it is rejected under the same rationale as claim 22.

As per claim 53, which is dependent on claim 33, it is rejected under the same rationale as claim 27.

As per independent claim 54, it is rejected under the same rationale as claims 1 and 19.

As per independent claim 55, it is rejected under the same rationale as claims 1 and 27.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 10 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin in view of MacKay (US 5,718,520).

As per claim 10, which is dependent on claim 1, Tonkin does not disclose the one or more media/finishing attributes comprises cropping. MacKay discloses cropping feature in col. 4, line 30. It would have been obvious to an artisan at the time of the invention to use the teaching from MacKay of including cropping to the media/finishing attributes in Tonkin's system since it would allow the user to adjust to make the document look better.

As per claim 42, which is dependent on claim 33, it is rejected under the same rationale as claim 10.

7. Claims 11 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin in view of Sperry et al ("Sperry", US 5,995,723).

As per claim 11, which is dependent on claim 1, Tonkin does not disclose the one or more media/finishing attributes comprises shifting. Sperry discloses document attributes including image-shifts. It would have been obvious to an artisan at the time of the invention to use the teaching from Sperry of including shifting to the media/finishing attributes in Tonkin's system since it would allow the user to adjust to make the document look better.

As per claim 43, which is dependent on claim 33, it is rejected under the same rationale as claim 11.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6213652 B1 to Suzuki, Akihiro et al. discloses job scheduling system for print processing.

US 6134018 A to Dziesietnik, Ghilad et al. discloses method and apparatus for creating personalized documents that include variable data.

US 6026258 A to Fresk, J. Sean et al. discloses method for temporarily locking out print jobs on a network copier when a copier user is present.

US 5978559 A to Quinion, Susan M. discloses user interface for distributed printing system.

US 5946461 A to Landry, John E. et al. discloses system for positioning image information on special print media sheets.

US 5760775 A to Sklut, Robert L. et al. discloses apparatus and method for programming a job ticket in a document processing system.

US 5699494 A to Colbert, Carl Lee et al. discloses remote replication of printer operator panel.

Inquiries

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon (Gary) D Nguyen whose telephone number is 703-

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305-8318. The examiner can normally be reached on Monday - Friday from 8 AM to 5:30 PM with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kistine L Kincaid can be reached on 703-308-0640. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Nhon (Gary) Nguyen
July 23, 2003


KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
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